

REMARKS/ARGUMENTS

Claims 1-37 were pending. In this response, claims 1-17 are canceled, claim 18, 27 and 35 are amended and new claims 38-50 are submitted for entry and examination. Therefore, following this amendment, claims 18-50 will be pending.

In the Office Action, the Examiner rejected claims 1-37 under 35 USC §112, ¶1 as failing to comply with the enablement requirement, citing to claims 1, 10, 13, 18, 27 and 35 as having subject matter that is not enabled by the specification. Although claims 1, 10 and 13 have been cancelled, Applicant nonetheless respectfully traverses each of the nonenablement positions set forth in the Office Action. The Examiner also rejected claims 1, 5-9, 11-12, 14-18, 22-26 and 28-35 under 35 USC §102(e) as being anticipated by U.S. Pat. Pub. No. 2003/0028512 ("Stensmo") and rejected claims 2-4, 19-21 and 36-37 under 35 USC §103(a) as being unpatentable over Stensmo in view of U.S. Pat. Pub. No. 2002/0156778 ("Beeferman"). The rejections are respectfully traversed and reconsideration is requested in view of the remarks herein.

§112, ¶1 Rejection

The Examiner asserted that a number of claim elements include subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully disagrees as to each such element, including elements of claims now canceled. What follows is a list of the subject matter the Examiner apparently asserted that is not found in the specification with sufficient description to be enabled, with references to examples in the specification where such subject matter is indeed described (paragraph references are to the originally filed specification):

"predetermined set of elements": The Examiner apparently interpreted this to be the predetermined set of stable elements. That is not the case. The predetermined set of stable elements is a distinct concept. The term "predetermined" is used in claims to indicate that the claim does not require an explicit step of determining, but such steps could occur outside the claimed method. As an example of a predetermined set of elements, the set could comprise HTML elements or XML elements [¶26], or characters, words, symbols. [¶27] See also Fig. 2. Applicant

submits that an ordinarily skilled artisan could look at a document comprising text, a document comprising HTML code, or other document and readily identify elements of the documents and from the elements so identified, compile a set of elements found in one or more documents.

“desired element”, “first sequence of elements” and manner in which “desired element” is connected to “related document”: A desired element may be any element that is desired by a user system for a user. [¶27] It is not appropriate to require that all possible desires of end users of the invention be spelled out, but several examples are shown. For example, the user might desire a snippet of a page that shows top news stories. [¶5] That “desired element” would be connected to the first sequence of elements in that a document (the “related document”) containing the first sequence of elements would also have therein the element desired. The claimed steps can be used to find the desired element in a second document (the claimed “document”, which is distinct from the “related document”). [¶¶6, 40, 44-46]

“generating one or more search queries from the first sequence of elements”: Where the sequence of elements is represented as a string, the search queries can be represented as substrings of the sequence of elements. For example, five search strings of length five might be generated from a sequence of elements (labelled “original sequence”). [¶44] It should be apparent upon reading the specification that these substrings can be generated by taking five consecutive elements from the original sequence wherein each of the substrings begin at a different element and include the desired element. The desired element is the element underlined in the description. [¶40]

“comparing the second sequence of elements with one or more search queries to produce one or more comparison results”: An example of a first and second sequence of elements being compared is shown. [¶48] After reading the specification, it should be apparent that the original sequence of elements can be determined from scanning the first document and the new sequence of elements can be determined from scanning the second document and that these sequences can be compared. [¶¶36-37, 47-50]

“determining the desired element in the document from the one or more comparison results”: After reading the specification, it should be apparent to the ordinarily skilled artisan that, given a desired element in a first document, a sequence of elements can be determined for the first document and can be compared against a sequence of elements determined for a second document. [See, for example, ¶35 and the examples shown in Figs. 6-11; see also ¶32] Examples of comparisons include exact comparisons of sequences of elements [¶¶42-43], best matches [¶50], or fuzzy searches [¶¶48-49].

“building a second sequence of elements from the document”: After reading the specification, it should be apparent to the ordinarily skilled artisan that a sequence of elements can be built from a document. The first sequence of elements is of a related document and the sequencing of both documents can be done in a similar manner. [¶36] One possible connection between the second sequence of elements and the desired element of the related document is that the second document contains the desired element, but within a changed document structure. [¶¶5, 35] As specified in the claims, the second sequence is built for the document and the desired element is a known element of the related document, wherein the “document” and “related document” are distinct documents.

“the document is related [to the related document] by an expected similarity”: As an example of expected similarity, documents that represent actively updated web pages are expected to remain more or less the same, so that two versions of the web page taken at different times are expected to be “similar”. [¶35]

“a search query with a position of the desired element closest to a position of the desired element in the second sequence of elements as the best match”: In one example, each element of a sequence has an index indicating its position in the sequence. [¶47] Applicant submits that finding an index of an item in a sequence of items is a trivial operation. For a matching search query, a document can be traversed [¶40] to find a match. After reading the specification, it should be apparent to the ordinarily skilled artisan that given a number of search queries that match different portions of the second sequence (i.e., different positions), that the one

with the most similar position would be a better match. Notwithstanding this traversal, claim 27 is amended to further clarify its scope.

In view of the above, Applicant submits that the specification as filed fully enables each claim element.

Cited References

Stensmo is directed to indexing documents such that they can be retrieved without requiring exact querying and does so by indexing documents using statistical models. With the statistical models, search and retrieval can be such that, given a set of keywords forming a query, related keywords can be determined and used to refine the query based on the related keywords and provide users with lists of related document to aid in the searching process. Relatedness of documents is determined using probabilistic modelling.

Beeferman was cited for the proposition that is was known to use tolerance levels to determine one or more query.

Cited References Distinguished

Claims 18, 35 and 38 are the remaining independent claims. Each of those claims, and therefore also the claims dependent therefrom are allowable over the cited references as those references, alone or in combination, fail to disclose or suggest each element of claim 1. For example, claim 18 recites “determining one or more search queries from the first sequence of elements” and “searching the second document by comparing the second sequence of elements with the one or more search queries to produce one or more comparison results” among other elements and those elements are not disclosed or suggested in the cited references.

As best understood, Stensmo’s approach is to use the context windows on one document to generate a model for searching for that document, not searching for a related document or within a related document. Additionally, in Stensmo, there is no concept of a predetermined set of stable elements from which to build a sequence of stable elements, much less two sequences of stable elements. Beeferman does not provide the missing elements and was not cited for that purpose. Additionally, it is not clear that one could combine Stensmo and Beeferman to provide any of the missing elements.

For at least those reasons, claim 18 is allowable over the cited references and claims dependent therefrom are also allowable. Thus, Applicant submits that the rejections of

individual dependent claims need not be addressed here, even though it appears that some of the citations to Stensmo do not actually show what the Examiner asserts they show.

As for claim 35, it also recites "determining one or more search queries from the first sequence of elements" and "searching the second document by comparing the second sequence of elements with the one or more search queries to produce one or more comparison results" among other elements and those elements are not disclosed or suggested in the cited references. Claims 36-37 dependent on claim 35 are also allowable for at least those reasons.

As for claim 38 and claims 39-50 dependent therefrom, claim 38 recites "searching the second sequence of elements of the second document according to the one or more search queries to produce one or more search results" and "determining the desired element in the second document from the one or more search results". At least those elements are not disclosed or suggested in the cited references and therefore claims 38-50 are allowable.

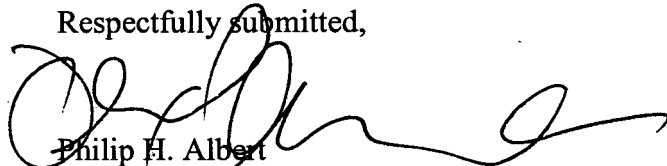
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

Dated: 1/27/05


Philip H. Albert
Reg. No. 35,819

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200 Fax: 415-576-0300
PHA:dk
60405362 v1